

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

I. Status of the Claims

Claims 1, 10, and 20-22 are currently being amended.

Claims 36-42 are being added.

Support for the amendments to claims 1, 10 and 20-22 are discussed below in relation to the rejection under 35 U.S.C. § 112, first paragraph. New claims 36-39 are similar to previously presented claims 23-26. New claims 40-42 add the amendment of claim 1 to claims 20 to 22 respectively. Thus, the foregoing amendment does not add new matter.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-22 and 33-42 are now pending in this application.

II. Rejection Under 35 U.S.C. § 112, first paragraph

The Examiner rejected claims 1-22 and 33-35 under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the written description requirement. Office Action at 2. Specifically, the Examiner is of the opinion that the specification “does not indicate that, during aspiration, the hollow pin is at an offset distance from the animal cell colony such that the hollow pin is not in contact with the animal cell colony.” *Id.* Applicants respectfully traverse this ground for rejection.

Solely to expedite prosecution, and not acquiescing in the propriety of the rejection, Applicants have amended claim 1, from which claims 2-9 and 17-19 depend, to indicate that the hollow pin of the claimed apparatus has “an inside diameter suitable for picking animal cell colonies of a size that is smaller than said inside diameter.” The basis for the amendment to claim 1 is found in the specification at page 12, lines 13-16. The cited text of the specification makes clear that the inner diameter of the pin needs to be greater than the size of the colony being picked:

In the present embodiment, the inner pin 64 has an inside diameter of 0.7 mm an outside diameter of 1.07 mm. The outer pin 62 is 35 mm long and has a 5 mm outer diameter, tapering to 4.2 mm at its end, and a 3.2 mm inner diameter. These dimensions are suitable for picking cell colonies of average size circa 0.5 mm.

Specification at page 12, lines 13-16 (emphasis added). Thus, the inside diameter of the inner pin is larger than the colonies to be picked. Having a pin diameter greater than the colony size ensures that the pin does not contact the colony during picking, and also that the pin diameter is large enough to allow the colony to be aspirated as a whole. Consequently, the colony is not disrupted (*i.e.*, broken into pieces).

Additionally, Applicants have amended claims 10 and 20-22 to remove reference to the hollow pin of the claimed apparatus being “offset from an animal cell colony” or “at an offset distance” or “offset from the animal cell colony by an offset distance such that the distal end of the hollow pin is not in contact with the animal cell colony”. Claims 11-16, 20 and 33-35 depend from claim 10. Amended, claims 10 and 20-22 currently recite that the distal end of the hollow pin is “immersed in the medium over the animal cell colony...” The basis for the phrase “over the animal cell colony” may be found in the specification at page 17, line 17 which describes the colony picking process as illustrated in Figure 12. The step entitled “Fire” is described as:

“Fire” (i.e. lower) pin to colony picking position with the end of the pin introduced into the medium *over the target cell colony* by offset ‘d2’.

Specification at page 17, lines 16-17 (emphasis added).

Applicants have also amended claim 10 to specify that “the at least one hollow pin comprising an inner pin and an outer pin, wherein the inner pin is recessed axially inside an end of the outer pin.” Support for amendment to claim 10 can be found in the specification in the description of Figures 6 and 7 on page 12. Specifically, the description of Figure 6 explains that the “hollow pin 26 comprises both outer and inner pins 62 and 64.”

Specification at page 12, lines 5-6. Additionally, the description for Figure 7 states that:

[t]he inner and outer pins 64 and 62 can be seen, as well as the motor 60 and connecting rod 66. As is shown, the end of the inner pin 64 is recessed axially inside the end of the outer pin 62 by a distance ‘d1’.

Specification at page 12, lines 19-21. An outer and inner pin, with the inner pin being recessed axially inside the outer pin, prevents the inner pin from mechanically pinching a colony against the container base during picking, and allows the outer pin to form a seal with the container base without contacting the colony thereby assisting aspiration by the inner pin.

Therefore, Applicants believe that the above amendments render the Examiner’s rejection moot and as such respectfully request that the Examiner reconsider and withdraw the rejection.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment,

to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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